

REMARKS

In the outstanding office action, claims 1-32 were presented for examination. Claims 1-32 were rejected under 35 U.S.C. §103(a) as being unpatentable in view of United States Patent No. 3,121,355 issued to Morel et al.

In the instant amendment applicant has amended claims 1, 27 and 32 to include the limitation of “wherein the cap is a tubular member adapted for use on the spin-on filter”, which was previously submitted in dependent claim 2. Thus, the present amendment does not include new subject matter into claims 1, 27 and 32 nor would such an amendment require further search and/or consideration. In addition, claim 2 has been amended to reflect the amendments to claim 1.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Applicant respectfully asserts that the claims as previously presented sufficiently distinguish from the prior art. Specifically, claims 1, 27 and 32, as amended, include among other limitations “a tubular member adapted for use on the spin-on filter”.

In contrast, the Morel et al. ('355) disclosure is directed to a cap, wherein “the hand of the operator is fully protected from the heat of the cap and from the steam or hot air which may be discharged from the partially removed cap, as is conventionally

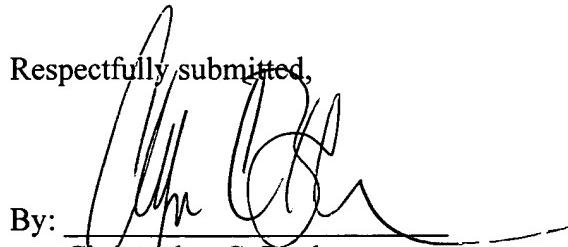
illustrated in Fig. 5". Column 2, lines 37-39. Thus, Morel et al. fails to teach or disclose "a tubular member adapted for use on the spin-on filter". In addition, the Morel et al. disclosure fails to motivate or suggest modification of its invention as it specifically teaches away from "tubular members" in that it is designed for removing hot radiator caps so that steam may escape from the radiator without injuring the operator.

Claims 2-26 and 28-31 variously depend directly or indirectly from claims 1 and 27 and are therefore believed to be allowable for at least the same reasons as claims 1 and 27, in addition to introducing additional limitations.

In view of the above, it is respectfully submitted that the instant application is in a condition for further examination. Such action is earnestly solicited. If for any reason the Examiner feels that consultation with Applicant's attorney would be helpful in the advancement of the prosecution, he is invited to call the telephone number below for an interview.

If there are any charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,
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